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OFFICE OF PETITIONS

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ATTENTION: STEPHEN G. KALINCHAK, LEGAL
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In re Patent of Heidi Lopez de Diego et al.	:	DECISION ON REQUEST
Patent No. 7,767,683	:	FOR RECONSIDERATION OF
Issue Date: August 3, 2010	:	PATENT TERM ADJUSTMENT
Application No. 10/568,572	:	AND NOTICE OF INTENT TO
Filing Date: August 14, 2006	:	ISSUE CERTIFICATE OF
Attorney Docket No. 453-US-PCT	:	CORRECTION

This is a decision on the petition filed October 1, 2010, which is being treated as a petition under 37 C.F.R. § 1.705(d) requesting the patent term adjustment indicated on the patent be corrected to indicate the term of the patent is extended or adjusted by one hundred fifty-five (155) days.

The petition to correct the patent term adjustment indicated on the patent to indicate the term of the patent is extended or adjusted by one hundred fifty-five (155) days is **GRANTED to the extent indicated herein.**

The Office will *sua sponte* issue a certificate of correction setting forth a patent term adjustment of 112 days. Pursuant to 37 C.F.R. § 1.322, the Office will not issue a certificate of correction without first providing an assignee or a patentee an opportunity to be heard. Accordingly, Patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. In other words, if Patentees wish to file a response to the instant decision disputing the 112-day determination, the response must be filed within one (1) month or thirty (30) days, whichever is longer, from the mail date of this decision. Extensions of time are not available under 37 C.F.R. § 1.136.

No portion of this decision should be construed as a waiver of the requirement, set forth in 35 U.S.C. § 154(b)(4), that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. § 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

Background

The patent issued August 3, 2010. The patent sets forth a patent term adjustment determination of 96 days, which is the sum of 212 days of delay under 37 C.F.R. § 1.703(a) ("A Delay") and

144 days of delay under 37 C.F.R. § 1.703(b) ("B Delay") reduced by 260 days of delay under 37 C.F.R. § 1.704 ("Applicant Delay").

The petition asserts the correct patent term adjustment is 155 days, which is the sum of 212 days of A Delay and 144 days of B Delay reduced by 201 days of Applicant Delay.

Issue 1

The Office issued a Notice of Allowance on March 22, 2010.

A request for a corrected filing receipt and a Supplemental Application Data Sheet ("Supplemental ADS") were filed May 24, 2007.

On May 27, 2007, the Office issued a response to the May 24, 2007 papers.

The petition asserts the Office should have entered a 4-day reduction in patent term adjustment for delay under 37 C.F.R. § 1.704(c)(10) based on the facts above.

The Office has reviewed the record and agrees the submission of the May 24, 2007 papers warrants a 4-day reduction for delay under 37 C.F.R. § 1.704(c)(10).

Issue 2

A Request to Correct Inventorship, a second Supplemental ADS ("ADS2"), and other papers were filed June 2, 2010.

On June 21, 2010, the Office issued a response to the June 2, 2010 papers.

The petition states, with emphasis in the original,

A review of the PAIR/PALM system reveals that two entries of Applicant Delay of 20 days each have been entered with regard to the [June 2, 2010 papers], apparently running concurrently from [June 2, 2010, to June 21, 2010]. However, only one period of delay of 20 days is appropriate for this post-allowance filing.

The Office has reviewed the record and agrees the papers filed June 2, 2010, do not warrant two separate 20-day reductions in patent term adjustment under 37 C.F.R. § 1.704(c)(10). In other words, the June 2, 2010 papers only warrant a single 20-day reduction in patent term adjustment.

Issue 3

As previously noted:

1. The Office issued a Notice of Allowance on March 22, 2010,
2. A Supplemental ADS was filed May 24, 2007, and
3. ADS2 was filed June 2, 2010.

A third Supplemental ADS (“ADS3”) was filed June 22, 2010.

The Office entered a 43-day reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(10) as a result of the submission of ADS3.

The petition states the submission of ADS3 should not have resulted in any reduction in patent term adjustment.

37 C.F.R. § 1.704(c)(10) states,

[Upon] [s]ubmission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed ... the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

- (i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or
- (ii) Four months.

Clarification of the Office’s interpretation of the scope of 37 C.F.R. § 1.704(c)(10) is set forth in Manual of Patent Examining (“MPEP”) § 2732 (8th ed., Rev. 7, July 2008). MPEP § 2732 states,

37 CFR 1.704(c)(10) establishes submission of an amendment under 37 CFR 1.312 or other paper after a notice of allowance has been given or mailed as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application.... Certain papers filed after allowance are not considered to be a failure to engage in reasonable efforts to conclude processing or examination of an application. See Clarification of 37 CFR 1.704(c)(10) – Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance has been Mailed, 1247 Off. Gaz. Pat. Office 111 (June 26, 2001).

The submission of the following papers after a “Notice of Allowance” is not considered a failure to engage in reasonable efforts to conclude processing or examination of an application:

- (1) Fee(s) Transmittal (PTOL- 85B);
- (2) Power of Attorney;
- (3) Power to Inspect;
- (4) Change of Address;
- (5) Change of Status (small/not small entity status);
- (6) a response to the examiner’s reasons for allowance or a request to correct an error or omission in the “Notice of Allowance” or “Notice of Allowability;” and
- (7) letters related to government interests (e.g., those between NASA and the Office).

Papers that will be considered a failure to engage in reasonable efforts to conclude processing or examination of an application include:

- (1) a request for a refund;
- (2) a status letter;
- (3) amendments under 37 CFR 1.312;
- (4) late priority claims;
- (5) a certified copy of a priority document;
- (6) drawings;
- (7) letters related to biologic deposits; and
- (8) oaths or declarations.

The petition states ADS3 changed “the email address of the practitioner and an inventor’s mailing address,” and contends ADS3 falls within the “Change of Address” exception listed above.

The petition states ADS3 changed “the email address of the practitioner.” A review of ADS3 and ADS2 indicates ADS3 did not change the e-mail address information in the Correspondence Information section. Instead, ADS3 simply added an e-mail address into the portion of ADS3 setting forth address information for the assignee.

The petition states ADS3 changed an inventor’s mailing address. However, ADS3 did not change the mailing address for any inventor. Instead, ADS3 changed the city portion of the residential address for one inventor.

Pursuant to 37 C.F.R. § 1.76(c)(2), a supplemental ADS “must identify the information that is being changed, preferably with underlining for insertions, and strike-through or brackets for text removed.” ADS3 fails to identify the information that is being changed. Therefore, ADS3 was improper.

An improper supplemental ADS filed to add an e-mail address for an assignee and to change the residential address for an inventor is not a paper which falls within the previously identified “Change of Address” exception. Therefore, the entry of the 43-day reduction in patent term adjustment based on the submission of ADS3 was proper.

Conclusion

The correct patent term adjustment is 112 days, which is the sum of 212 days of A Delay and 144 days of B Delay reduced by 244 days of Applicant Delay.

The Office acknowledges submission of the \$200.00 fee set forth in 37 C.F.R. § 1.18(e). No additional fees are required.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the patent is extended or adjusted by **two hundred twelve (212) days**.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.



Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT NO. : 7,767,683 B2
APPLICATION NO. : 10/568,572
DATED : August 3, 2010
INVENTOR(S) : Heidi Lopez de Diego et al.

DRAFT

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the Title page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 96 days.

Delete the phrase "by 96 days" and insert -- by 112 days--